

REMARKS

This Amendment is submitted in response to the Office Action dated December 5, 2006 and the Notice of Non-Compliant Amendment dated August 6, 2007. In the Office Action, the Patent Office rejected Claims 1, 2 and 8 under 35 U.S.C. §102(b) as being anticipated by *Ackalusky*; rejected Claims 1, 3, 8, 13 and 16-18 under 35 U.S.C. §102(b) as being anticipated by *Taylor*; rejected Claim 2 under 35 U.S.C. §103(a) as being unpatentable over *Taylor* in view of *Ackalusky* and further in view of *Perkins*, *Pagnini*, *Blant*, *Rizzuto*, *Oshio*, *Suzuya Shokuhin*, (hereinafter "*Suzuya*"), and *Smith*; and rejected Claims 4-7, 9-12, 14, 15, 19 and 20 under 35 U.S.C. §103(a) as being unpatentable over *Taylor* in view of *Ackalusky*, *Perkins*, *Pagnini*, *Blant*, *Rizzuto*, *Oshio*, *Suzuya Shokuhin*, and *Smith* and further in view of *Huffer et al.*, *Penick et al.*, *Freedman et al.*, *Lipper*, *Moravick et al.*, *Shin*, *Knoerzer et al.*, *Gottschalk*, *Goldstein*, *Witkowski et al.*, *McClung et al.*, and *Bellet*.

In the Notice of Non-Compliant Amendment, the Patent Office indicated that the amended claims do not comply with the requirements 37 CFR 1.121 because the amended claims do not include all markings in accordance with 37 CFR 1.121 to indicate all changes. Applicant respectfully submits that the claims as currently amended comply with the requirements 37 CFR 1.121.

By the present Amendment, Applicant amended Claims 1, 6, 8, 9,

13, 14 and 16. Applicant asserts that the amendments to the claims and the remarks that follow overcome the objections and rejections made by the Patent Office and place the application in condition for allowance. Notice to that effect is requested.

In the Office Action, the Patent Office rejected Claims 1, 2 and 8 under 35 U.S.C. 102(b) as being anticipated by *Ackalusky*.

The Patent Office stated:

In regard to claim 1, *Ackalusky* discloses an apparatus for collecting drips from a frozen treat, the apparatus comprising a base defined by a perimeter wherein the base has a top layer (24) covering a bottom layer (18) wherein the base is planar and further wherein the top layer is an absorbent material, said apparatus further comprising a lip (14) on the perimeter of the base wherein the lip extends outward with respect to the top layer of the base, and an opening in the base extending from the top layer to the bottom layer wherein the opening is located inside the perimeter of the base. This is all that claim 1 positively recites. It is noted that claim 1 does not recite that the top layer covers all of the bottom layer. In regard to claim 2, *Ackalusky* discloses that the bottom layer is plastic. Claim 8 is rejected for the reasons given above.

(See Office Action, Page 2).

However, independent Claim 1, as amended, requires that the outer edge of the top layer is adjacent to the lip. Moreover, independent Claim 8, as amended, requires that the outer edge of the absorbing means is adjacent to the lip.

Ackalusky merely discloses an apparatus containing a vinyl resin or polyethylene open-top preshaped container guard with a

resilient sponge rubber sealing block secured about an opening in the guard. Further, the sealing block does not extend to the lip of the container guard.

Nowhere does Ackalusky disclose that the outer edge of the top layer is adjacent to the lip, as required by independent Claim 1. Further, nowhere does Ackalusky disclose that the outer edge of the absorbing means is adjacent to the lip, as required by amended Claim 8.

Under 35 U.S.C. §102(b), anticipation requires that a single reference discloses each and every element of Applicant's claimed invention. *Akzo N.V. v. U.S. International Trade Commission*, 808 F.2d 1471, 1479, 1 USPQ 2d. 1241, 1245 (Fed. Cir. 1986). Moreover, anticipation is not shown even if the differences between the claims and the reference are "insubstantial", and one skilled in the art could supply the missing elements. *Structure Rubber Products Co. v. Park Rubber Co.*, 749 F.2d. 707, 716, 223 USPQ 1264, 1270 (Fed. Cir. 1984).

Since Ackalusky fails to disclose the elements specifically defined in amended independent Claims 1 and 8, and Claim 2 depends from Claim 1, Applicant asserts that the rejection of Claims 1, 2 and 8 under 35 U.S.C. §102(b) has been overcome and should be withdrawn. Notice to that effect is requested.

In the Office Action, the Patent Office rejected Claims 1, 3, 8, 13 and 16-18 under 35 U.S.C. 102(b) as being anticipated by

Taylor.

The Patent Office stated:

In regard to claim 1, Taylor discloses an apparatus for collecting drips from a frozen treat, the apparatus comprising a base defined by a perimeter wherein the base has a top layer (e.g. 8) covering a bottom layer (e.g. 9), wherein the base is planar and further wherein the top layer is an absorbent material, said apparatus further comprising a lip (e.g. 7) on the perimeter of the base wherein the lip extends outward with respect to the top layer of the base, and an opening in the base extending from the top layer to the bottom layer wherein the opening is located inside the perimeter of the base. In regard to claim 3, Taylor discloses the absorbent material is paper and claim 8 is rejected for the reasons given above in regard to claim 8. In regard to claim 13, Taylor discloses connecting the cover to the base. In regard to claim 17, Taylor discloses laminating the cover.

(See Office Action, pages 2 and 3.)

However, independent Claim 1, as amended, requires a bottom layer that is made from a material that is rigid. Further, Claim 1 requires a lip on the base that extends to a point above the top layer. Still further, Claim 1 requires that the bottom layer extends to a point outside of the outer edge of the top layer without overlapping the absorbing means. Moreover, Claim 1 requires that the lip is perpendicular to the base.

Independent Claim 8, as amended, requires a base that is made of a material that is rigid. Further, Claim 8 requires a lip on the perimeter of the base that extends outward perpendicularly with respect to the top side of the base. Still further, Claim 8 requires that the base extends to a point outside of the outer edge

of the absorbing means without overlapping the absorbing means. Moreover, Claim 8 requires that the lip extends to a point above the absorbing means.

Independent Claim 13, as amended, requires that the base is made from a material that is rigid. Further, Claim 13 requires a lip on the perimeter of the base that is perpendicular to the base. Still further, Claim 13 requires that the perimeter of the cover is less than the perimeter of the base. Moreover, Claim 13 requires that the lip extends to a point above the first side of the cover.

Taylor merely discloses a shield disposed against the base of a frozen confection that has a passage through which the handle extends. Further, the moisture-absorbing material 9 resides on a foldable base 6 (See *Taylor*, FIG. 1 and col. 2, lines 44-48), in contrast to the rigid base of the present invention. Still further, the moisture-absorbing material extends to the edge of the base, and the moisture-absorbing material and the base share the same perimeter (see *Taylor*, FIG. 1), in contrast to the base that extends to a point outside of the outer edge of the absorbing means and has a larger perimeter than the perimeter of the absorbing means as required by the claims of the present invention. Moreover, the base has a lateral portion connected to the base's edge that extends downwardly in a direction away from the body lengthwise of the handle. The lateral portion does not extend perpendicularly relative to the base, in contrast to the present

invention.

Nowhere does *Taylor* disclose a bottom layer that is made from a material that is rigid, as required by amended Claim 1. Further, nowhere does *Taylor* disclose a lip on the base that extends to a point above the top layer, as required by amended Claim 1. Still further, nowhere does *Taylor* disclose that the bottom layer extends to a point outside of the outer edge of the top layer without overlapping the absorbing means. Moreover, nowhere does *Taylor* disclose that the lip is perpendicular to the base, as required by amended Claim 1.

Nowhere does *Taylor* disclose a base that is made from a material that is rigid, as required by amended Claim 8. Still further, nowhere does *Taylor* disclose a lip on the perimeter of the base that extends outward perpendicularly with respect to the top side of the base, as required by amended Claim 8. Still further, nowhere does *Taylor* disclose that the base extends to a point outside of the outer edge of the absorbing means without overlapping the absorbing means. Moreover, nowhere does *Taylor* disclose that the lip extends to a point above the absorbing means, as required by amended Claim 8.

Nowhere does *Taylor* disclose a base that is made from a material that is rigid, as required by amended Claim 13. Further, nowhere does *Taylor* disclose a lip on the perimeter of the base that is perpendicular to the base, as required by amended Claim 13.

Moreover, nowhere does *Taylor* disclose that the lip extends to a point above the first side of the cover, as required by amended Claim 13.

Therefore, *Taylor* does not disclose the novel elements required by Claims 1, 3, 8, 13 and 16-18. Because *Taylor* fails to disclose the elements specifically defined in amended Claims 1, 8 and 13, and because Claims 3 and 16-18 depend from independent Claims 1 and 13, Applicant asserts that the rejection of Claims 1, 3, 8, 13 and 16-18 under 35 U.S.C. §102(b) has been overcome and should be withdrawn. Notice to that effect is requested.

In the Office Action, the Patent Office rejected Claim 2 under 35 U.S.C. §103(a) as being unpatentable over *Taylor* in view of *Ackalusky* and further in view of *Perkins*, *Pagnini*, *Blant*, *Rizzuto*, *Oshio*, *Suzuya* and *Smith*.

The Patent Office stated:

Claim 2 differs from *Taylor* in the recitation that the bottom layer is plastic whereas *Taylor* discloses a nonabsorbent paper material. *Ackalusky* can be relied on to teach it was well established to employ plastic, paper or cardboard as a bottom layer in an anti-drip device. To modify *Taylor* and substitute one conventional material of construction for another conventional material of construction for its art recognized and applicants intended function would therefore have been obvious. *Perkins*, *Pagnini*, *Blant*, *Rizzuto*, *Oshio*, *Suzuya*, and *Smith* are relied on as further evidence of the conventionality of anti-drip devices.

(See Office Action, pages 3 and 4.)

However, independent Claim 1, as amended, requires that the

outer edge of the top layer is adjacent to the lip. Still further, Claim 1 requires a bottom layer that is made from a material that is rigid. Still further, Claim 1 requires a lip on the base that extends to a point above the top layer. Moreover, Claim 1 requires that the lip is perpendicular to the base. Claim 2 requires the apparatus of Claim 1 and further requires that the base is plastic. On page 3 of the Office Action, the Patent Office admits that Claim 2 differs from *Taylor* in the recitation that the base is plastic whereas *Taylor* discloses a nonabsorbent paper material. *Perkins, Pagnini, Blant, Rizzuto, Oshio, Suzuya* and *Smith* all merely teach drip trays that are made of some type of plastic. Nowhere does *Taylor* in view of *Perkins, Pagnini, Blant, Rizzuto, Oshio, Suzuya* and *Smith* teach the apparatus as required by amended Claim 1 from which Claim 2 depends.

The differences between Claim 2 and the teachings of *Taylor, Perkins, Pagnini, Blant, Rizzuto, Oshio, Suzuya* and *Smith* are such that the subject matter as a whole would not have been obvious at the time the invention was made to a person having ordinary skill in the art. Therefore, the rejection of Claim 2 under 35 U.S.C. §103(a) has been overcome and should be withdrawn. Notice to that effect is requested.

Still further, in the Office Action, the Patent Office rejected dependent Claims 4-7, 9-12, 14, 15, 19 and 20 under 35 U.S.C. §103(a) as being unpatentable over *Taylor* in view of

Ackalusky, Perkins, Pagnini, Blant, Rizzuto, Oshio, Suzuya and Smith and further in view of Huffer, Penick, Freedman, Lipper, Moravick, Shin, Knoerzer, Gottschalk, Goldstein, Witkowski, McClung and Bellet.

The Patent Office stated:

Claims 4-7 differ from the combination in the recitation that an adhesive sticker, a washable tattoo, a partition in the base or a mark is associated with the base respectively. As evidenced by Huffer, Penick, Freedman, Lipper, Moravick, Shin, Knoerzer, Gottshalk, Goldstein, Witkowski, McClung, and Bellet, it was notoriously conventional to provide an article that is to be associated with a product (such as a package associated with contents) with adhesive stickers, or washable tattoos, or partitions in the article such as the package (to allow for separation of an article of interest), or a mark. To modify the combination and provide these conventional elements for their art recognized and applicants intended function would therefore have been obvious.

In regard to Claims 9, 10, 11, and 12, the particular layer that the elements recited (such as the sticker or partition) are attached to, or associated with is seen to have been an obvious matter of choice.

Claims 19 and 20 recite that the cover is removed from the base and the base is used as a disk. The art taken as a whole discloses that the cover can be laminated or the cover element can be positioned on the base (such as in the teaching in Ackalusky). Whether one removes the cover and what one does with the base after removal of the cover is seen to have been an obvious matter of choice or design; especially since the art taken as a whole teaches converting articles of one utility such as packages into articles of other utility such as entertainment or amusement devices. Note, too, it was well established to associate drip catching absorbent layers with tray type structures either by bonding or just a loose attachment as is done,

for example, with meat trays.

(See Office Action, pages 4 and 5.)

However, independent Claim 1, as amended, requires that the outer edge of the top layer is adjacent to the lip. Still further, Claim 1 requires a bottom layer that is made from a material that is rigid. Still further, Claim 1 requires a lip on the base that extends to a point above the top layer. Moreover, Claim 1 requires that the lip is perpendicular to the base. Dependent Claims 4-7 depend from independent Claim 1.

Independent Claim 8, as amended, requires a base that is made from a material that is rigid. Still further, Claim 8 requires a lip on the perimeter of the base that extends outward perpendicularly with respect to the top side of the base. Moreover, Claim 8 requires that the lip extends to a point above the absorbing means. Dependent Claims 9-12 depend from independent Claim 8.

Independent Claim 13, as amended, requires a base that is planar. Further, Claim 13 requires that the base is made from a material that is rigid. Still further, Claim 13 requires a lip on the perimeter of the base that is perpendicular to the base. Moreover, Claim 13 requires that the lip extends to a point above the first side of the cover. Dependent Claims 15, 19 and 20 depend from independent Claim 13.

Claims 4-7 require the apparatus of independent Claim 1 and

further require an adhesive sticker on the base; a washable tattoo on the base; a partition in the base wherein the partition is removed from the base; and a mark printed on the base. Further, Claims 9-12 require the apparatus of independent Claim 8 and further require a sticker attached to the absorbing means; a partition in the absorbing means wherein the partition is separable from the absorbing means; a plurality of perforations partitioning the absorbing means; and a washable tattoo removably attached to the absorbing means. Further, Claims 14, 15, 19 and 20 require the method of independent Claim 13 further comprising the steps of perforating the cover to form a partition in the cover; partitioning the base with a plurality of perforations; removing the cover from the base to form a disk; and utilizing the base as a disk wherein the base is separated from the cover.

Nowhere do Ackalusky, Perkins, Pagnini, Blant, Rizzuto, Oshio, Suzuya, Smith, Huffer, Penick, Freedman, Lipper, Moravick, Shin, Knoerzer, Gottschalk, Goldstein, Witkowski, McClung or Bellet teach an apparatus, system, or method used when consuming a frozen treat, as required by independent Claims 1, 8 and 13. The above references disclose either removable items or novelties for games, boxes of food, or the like. On the contrary, Applicant's invention requires an apparatus, system or method used for consuming a frozen treat.

One of ordinary skill in the art would never have been

motivated to modify *Taylor* with *Ackalusky*, *Perkins*, *Pagnini*, *Blant*, *Rizzuto*, *Oshio*, *Suzuya*, *Smith*, *Huffer*, *Penick*, *Freedman*, *Lipper*, *Moravick*, *Shin*, *Knoerzer*, *Gottschalk*, *Goldstein*, *Witkowski*, *McClung* and *Bellet* in the manner suggested by the Patent Office in formulating the rejection of the claims under 35 U.S.C. §103(a). It is submitted that the question under §103(a) is whether the totality of the art would collectively suggest the claimed invention to one of ordinary skill in this art. *In re Simon*, 461 F.2d 1387, 174 USPQ 114 (CCPA 1972).

That elements, even distinguishing elements, are disclosed in the art is alone insufficient. It is common to find elements somewhere in the art. Moreover, most, if not all, elements perform their ordained and expected functions. The test is whether the invention as a whole, in light of the teachings of the references in their entireties, would have been obvious to one of ordinary skill in the art at the time the invention was made. *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983).

It is insufficient that the art disclosed components of Applicant's system and method. A teaching, suggestion, or incentive must exist to make the combination made by Applicant. *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1988).

Moreover, a motivation to combine does not exist merely because references are analogous art, as alleged by the Patent

Office. The references must expressly or impliedly suggest the claimed invention, or the Patent Office must present a convincing line of reasoning as to why the Applicant would have found the claimed invention to have been obvious in light of the teachings of the references. *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985).

With the analysis of the deficiencies of *Taylor*, *Ackalusky*, *Perkins*, *Pagnini*, *Blant*, *Rizzuto*, *Oshio*, *Suzuya*, *Smith*, *Huffer*, *Penick*, *Freedman*, *Lipper*, *Moravick*, *Shin*, *Knoerzer*, *Gottschalk*, *Goldstein*, *Witkowski*, *McClung* and *Bellet* in mind, as enumerated above, no reason or suggestion in the evidence of record exists why one of ordinary skill in the art would have been led to combine *Taylor*, *Ackalusky*, *Perkins*, *Pagnini*, *Blant*, *Rizzuto*, *Oshio*, *Suzuya*, *Smith*, *Huffer*, *Penick*, *Freedman*, *Lipper*, *Moravick*, *Shin*, *Knoerzer*, *Gottschalk*, *Goldstein*, *Witkowski*, *McClung* and *Bellet* to produce the claimed invention.

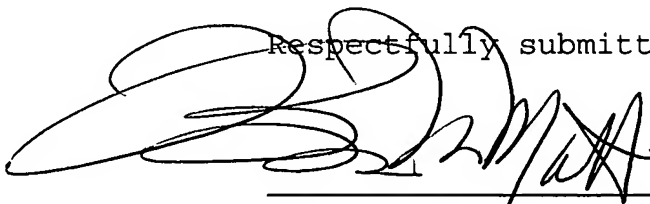
Further, Applicant submits that the Patent Office is merely "piece-mealing" references together, providing various teachings and positively defined limitations of Applicant's apparatus, system and method for collecting drips from a frozen treat. Of course, hindsight reconstruction of Appellant's invention is impermissible. Therefore, *prima facie* obviousness has not been established by the Patent Office as required under 35 U.S.C. §103(a).

In view of the foregoing, Applicant respectfully submits that

dependent Claims 4-7, 9-12, 14, 15, 19 and 20 distinctly define the present invention from *Taylor, Ackalusky, Perkins, Pagnini, Blant, Rizzuto, Oshio, Suzuya, Smith, Huffer, Penick, Freedman, Lipper, Moravick, Shin, Knoerzer, Gottschalk, Goldstein, Witkowski, McClung* and *Bellet*, taken singly or in combination. Accordingly, the rejection of Claims 4-7, 9-12, 14, 15, 19 and 20 under 35 U.S.C. §103(a) has been overcome and should be withdrawn. Notice to that effect is requested.

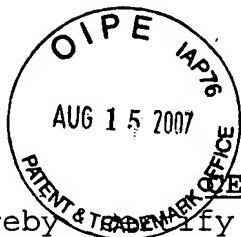
In view of the foregoing remarks and amendments, Applicant respectfully submits that all of the claims in the application are in allowable form and that the application is now in condition for allowance. If, however, any outstanding issues remain, Applicant urges the Patent Office to telephone Applicant's attorney so that the same may be resolved and the application expedited to issue. Applicant requests the Patent Office to indicate all claims as allowable and to pass the application to issue.

Respectfully submitted,



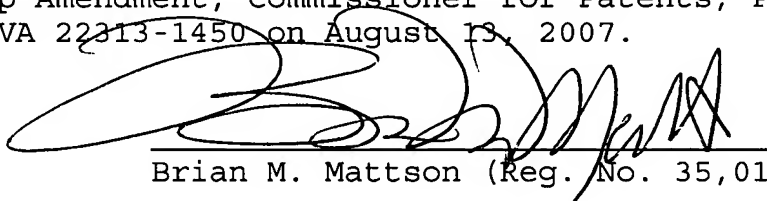
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I hereby ~~certify~~ ^{testify} that this **Amendment, Transmittal (in duplicate)** and **return receipt postcard** are being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on August 13, 2007.



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